REMARKS

The Examiner is thanked for her review of this application. Claims 1, 4, 8, 9, 10, 13, 14, 15, 17, and 22 have been amended to correct formalities associated with commas and element list termination using the word "and". Claims 1-23 remain pending after entry of the present Amendment.

Rejections under 35 U.S.C. § 103

Claims 1-23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Borman et al. ("Borman") (U.S. Patent No. 5,890,172) in view of Yohanan (U.S. Patent No. 5,737,560). These rejections are respectfully traversed.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one having ordinary skill in the art, to combine the references. Additionally, the references when combined must teach or suggest all the claim limitations. As discussed below, the Office has not established a *prima facie* case of obviousness because there is neither suggestion nor motivation, in either the references or in the knowledge of one having ordinary skill in the art at the time of the invention, to have combined the references in the manner proposed. Furthermore, the references when combined do not teach or suggest all of the claim limitations.

Borman teaches a computer implemented method for retrieving data from a network through a browser connected to the network. A first file includes information to identify contents of the file such as site identifiers corresponding to file locations on the network. The first file is displayed in the browser window. The first file is also parsed by a jumper to generate a list of site identifiers contained within the first file. The list of site identifiers is stored by the jumper and displayed in a jumper window. Upon user command, the jumper determines which of the stored site identifiers is currently selected and automatically selects the next. Next the jumper directs the browser to access the file at the site corresponding to the automatically

selected site identifier. Finally, the browser is directed to display the file the browser has retrieved in the browser window.

With respect to claim 1, Borman does not teach an attachment mechanism configured to retrieve an attachment from said selection mechanism and attach said attachment to an e-mail message in response to a user event as claimed by the present invention. Contrary to the Examiner's statement, Borman's teachings of a jumper window 300 (Figure 3) and a selection of a hot-link with a mouse (column 6, lines 55-60) are in no way related to an attachment mechanism or associated attachment operation. The jumper window 300 as shown in Figure 3 is taught as a display mechanism for a list of URLs associated with a network location that is actively displayed in a browser. Column 6, lines 55-60, of Borman refer to a drop-down list of parsed URLs that can be used to select, retrieve, and display the content associated with a particular URL. Borman does not teach in any respect the use of either the jumper window 300 or the drop down list of parsed URLs as an attachment mechanism configured to retrieve an attachment and attach said attachment to an email. Only hindsight afforded by the present invention combined with extrapolation of functionality beyond the teachings of Borman would allow the jumper window 300 and drop-down list of parsed URLs to be misconstrued as a teaching of an attachment mechanism capable of performing associated attachment operations.

The Examiner states the following: "Borman teaches that the attachment comprises a resource locator [claim 2] at column 7, lines 62-63, or source data [claim 3] associated with the current data resource at column 13, lines 32-38." However, column 7, lines 62-63 actually state the following: "A representative hot-link 514, is shown to contain both an URL 516 and a text portion 518." Contrary to the Examiner's inference, Borman does not identify the hot-link as an attachment to an email. Rather, the subject hot-link is identified simply as being one of a plurality of hot-links listed in a Yahoo™ search result summary.

The Examiner states the following: "Borman teaches selecting an attachment type [claim 4] at column 12, lines 56-61." However, column 12, lines 56-61 actually state the following:

"Similarly in another embodiment, the user can specify what types of results should be parsed (e.g., only categories). Alternatively, in another embodiment, the jumper parses all the site identifiers, but the user specifies how many or what type to display." The teachings of Borman at column 12, lines 56-61, are directed to parsing of URLs in accordance with at least one URL distinguishing characteristic. The teachings of Borman at column 12, lines 56-61 are not related at all to the selection of an attachment type (i.e., URL versus source data representation). Therefore, the Examiner's assertion that Borman teaches selecting an attachment type is without support.

Yohanan teaches a computer implemented method for permitting a computer system to access a network location using a browser application by activating a desktop icon. The method includes displaying a desktop icon associated with a file containing a network address corresponding to the network location. When the desktop icon is activated, a browser application or new browser window is instantiated, and the network address is passed to the browser. The browser then accesses the network location. The desktop icons configured to direct a browser to a network location are called "jumpsites".

With respect to claim 1, Yohanan does not teach a selection mechanism configured to select a portion of said current document in response to a user input. Furthermore, Yohanan does not teach an attachment mechanism configured to retrieve an attachment from said selection mechanism and attach said attachment to an email message in response to a user event, said attachment associated with said portion of said current document. The Examiner asserts that Yohanan teaches selecting a portion of a current document by selecting jumpsite icons that can be attached to email messages. The reality is that Yohanan does not teach selecting a portion of a current document. Rather, Yohanan teaches selection of jumpsite icons and the attachment of jumpsite icons to an email message. A jumpsite icon is a desktop icon that "jumps" the user to a designated web site or jumpsite (column 5, lines 45-47). The jumpsite icons only contain information related to a description of the jumpsite icon, the network address (e.g., URL) of the

web site to be associated with the jumpsite icon, and the jumpsite icon name (column 6, lines 1-5). Column 7, lines 45-50, of Yohanan teach away from the claimed invention by stating "If the recipient of the message does not have WebJumper installed, a text file appears when they double-click the icon. This file contains the URL information for the web site associated with the jumpsite icon, but does not contain the web page itself." In an even more clear example, column 9, lines 9-15, of Yohanan teach away from the claimed invention by stating "... the jumpsite file stores the URL but does not contain executable browser code." Thus, the jumpsite icons do not contain any source data for the file associated with the URL. Therefore, attaching a jumpsite icon to an email message as taught by Yohanan does not teach attaching source data or a portion of source data from a current document (e.g., web page) to an email message.

In summary, it is unambiguously clear that Borman does not teach either an attachment selection mechanism, an attachment type selection mechanism, or any associated attachment operation. The Examiner has acknowledged this fact to a limited extent by stating "However, Borman does not specifically teach attaching the attachment to an email message. Nor does Borman specifically teach a selection mechanism to select a portion of a current document for attachment to an email message." Furthermore, it is clear that Yohanan does not teach an attachment selection mechanism capable of selecting source data or a portion of source data from a current document (e.g., web page) to be attached to an email message.

Independent claims 7, 12, 17, and 23 are similar to independent claim 1 in that their respective methods and devices contain elements associated with a selection mechanism capable of selecting a portion of a current document and an attachment mechanism capable of attaching the selected portion of the current document to an email message. Therefore, the arguments previously set forth in support of independent claim 1 are also equally applicable to independent claims 7, 12, 17, and 23.

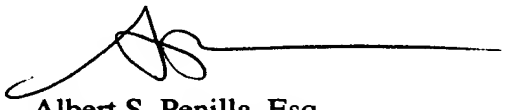
Neither the teachings nor the nature of the problem solved in either Borman or Yohanan, or the combination thereof, motivate or suggest to one of ordinary skill in the art at the time of

the invention to combine the reference teachings in a manner that would make the claimed invention obvious. Remembering that the references of Borman and Yohanan must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention, neither Borman nor Yohanan, nor the combination thereof, teach all of the claimed features of claims 1-23.

Thus, the Examiner has not established a *prima facie* case of obviousness. For at least these reasons, the Applicants respectfully request that the rejections of independent claims 1, 7, 12, 17, and 23 be withdrawn. For at least the same reasons, the Applicants respectfully submit that dependent claims 2-6, 8-11, 13-16, 18-22 are patentable over the cited art of record.

Accordingly, a notice of allowance is respectfully requested. If the Examiner has any questions concerning the present amendment, the Examiner is kindly requested to contact the undersigned at (408) 749-6900 x6903. If any other fees are due in connection with filing this amendment, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. SUNMP063). A duplicate copy of the transmittal is enclosed for this purpose.

Respectfully submitted,
MARTINE & PENILLA, LLP



Albert S. Penilla, Esq.
Reg. No. 39,487

MARTINE & PENILLA, LLP
710 Lakeway Drive, Suite 170
Sunnyvale, CA 94085
Telephone: (408) 749-6900
Customer Number 32291

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

MARKED UP AMENDMENT

In re the application of	
CARTER	Group Art Unit: 2174
Application No. 09/046,784	Examiner: Dela Torre, C.
Filed: March 23, 1998	Attorney Docket No. SUNMP063
For: METHOD AND APPARATUS FOR SELECTING ATTACHMENTS	

MARKED UP CLAIMS

1. (Amended) An apparatus comprising:

a browsing mechanism configured to render a current data resource in a display region of a graphical user interface, said current data resource comprising at least one current document, said browsing mechanism configured to navigate through a plurality of data resources;

a selection mechanism configured to select a portion of said current document in response to a user input; and

an attachment mechanism configured to retrieve an attachment from said selection mechanism and attach said attachment to an e-mail message in response to a user event, said attachment associated with said portion of said current document.

4. (Amended) The apparatus of claim 1, wherein said attachment mechanism is configured to select an attachment type of said attachment.

8. (Amended) The method of claim 7, further comprising the step of selecting a type of said attachment.

9. (Amended) The method of claim 7, wherein said step of retrieving said attachment comprises retrieving a resource locator of said current document.

10. (Amended) The method of claim 7, wherein said step of retrieving said attachment comprises retrieving source data associated with said current document.

13. (Amended) The computer program product of claim 12, further comprising computer readable code configured to cause a computer to receive user input to select a type of said attachment.

14. (Amended) The computer program product of claim 12, wherein said computer readable code configured to cause a computer to retrieve said attachment comprises computer readable code configured to cause a computer to retrieve a resource locator of said current document.

15. (Amended) The computer program product of claim 12, wherein said computer readable code configured to cause a computer to retrieve said attachment comprises computer readable code configured to cause a computer to retrieve source data associated with said current document.

17. (Amended) A memory configured to store data for access by a computer system, comprising:

a data structure stored in said memory and associated with a graphical user interface, said data structure comprising:

a browsing component comprising:

one or more methods configured to render a current data resource, said current data resource comprising at least one current document;

one or more navigation methods configured to navigate between a plurality of data resources;

one or more navigation components configured to invoke said one or more navigation methods of said browsing component in response to user input; [and]

one or more selecting components configured to select a portion of said current document in response to a user input; and

an attachment component comprising a method configured to retrieve an attachment from said selecting component and attach said attachment to an e-mail message in response to a user input, said attachment associated with said current document.

22. (Amended) The memory of claim 17, wherein said browsing component further comprises:

a stack configured to contain resource locators of navigated data resources; and

one or more methods configured to browse said navigated data resources by stepping forward and backward within said stack.